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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,847	03/29/2004	Yutaka Kimura	427-89	9114
23117	7590	07/28/2006	EXAMINER	
NIXON & VANDERHYE, PC			SHAW, CLIFFORD C	
901 NORTH GLEBE ROAD, 11TH FLOOR			ART UNIT	
ARLINGTON, VA 22203			PAPER NUMBER	

1725

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/810,847

Applicant(s)

KIMURA ET AL.

Examiner

Clifford C. Shaw

Art Unit

1725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9 and 10 is/are allowed.
- 6) ☒ Claim(s) 5-8 and 11-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

**Detailed Action**

1.) New prior art pertinent to the claims in this application has come to the attention of the examiner. The final rejection mailed on 11/21/2005 is withdrawn. The amendment after final filed by applicant on 2/16/2006 has been entered, and the claims therein are examined in the instant Office action.

2.) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3.) Claims 5-8 and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Japanese document no. JP2000-197971A taken with Haudrechy (6,274,084). The English abstract and paragraph 0015 of the computer generated translation of the Japanese document no. JP2000-197971A disclose a welding method for non-consumable electrode arc welding of SUS304 austenitic stainless steel using a gas mixture including the inert gas argon and up to 10% nitrogen gas. The claims differ from the teachings of the Japanese document no. JP2000-197971A in calling for: the stainless steel to have particular concentrations of Ca (in independent claim 6); in calling for particular concentrations of Al and Si in claims 8, 14, and 15; in calling for a fixed tube workpiece in claim 7; in calling for particular a workpiece thickness in claim 11; and in calling for particular welding parameters in claims 12 and 13. These differences do not

Art Unit: 1725

patentably distinguish over the prior art. At the time applicant's invention was made, it would have been obvious that the '304 stainless steel taught by the Japanese document no. JP2000-197971A would conform to the claimed concentrations of Ca, Al, and Si in view of the teachings of Haudrechy (6,274,084) that '304 stainless steel can include these constituents in the amounts claimed (see items "A" and "B" in Table 2 of Haudrechy (6,274,084)). In regard to the claimed workpiece features, it would have been obvious to have used the method of the Japanese document no. JP2000-197971A to weld any particular stainless steel workpiece, include one with the features claimed, the motivation being to secure the advantages of the method of the Japanese document no. JP2000-197971A for a particular workpiece. In regard to the claimed welding parameters, it would have been obvious to have practiced the method of the Japanese document no. JP2000-197971A with the same, the motivation being to adjust the weld parameters for a particular welding problem.

4.) Claims 9 and 10 are allowable over the prior art of record. None of the prior art of record teaches or suggests the welding method claimed wherein austenitic stainless steel is welded with a non-consumable electrode using the particular shield gas, in the manner set forth in claim 9. It is noted that the shield gas composition set forth in the claim comprises "an inert gas, nitrogen gas, and helium gas ...". The language "inert gas" is interpreted to mean any inert gas other than helium. Claim 10 is allowable at least because it depends from claim 9.


Art Unit: 1725

5.) Applicant's arguments filed 2/16/2006 have been fully considered but they are not persuasive. Claims 5-8 and 11-15 are considered to be unpatentable in view of the new grounds of rejection set forth above.

Any inquiry concerning this communication should be directed to Clifford C Shaw at telephone number 571-272-1182. The examiner can normally be reached on Monday through Friday of the first week of the pay period and on Tuesday through Friday of the second week of the pay period.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Patrick J. Ryan, can be reached at 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Clifford C Shaw  
Primary Examiner  
Art Unit 1725

July 26, 2006